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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/726,265 | 11/30/2000 | Rabindranath Dutta | AUS9-2000-0691-US1 | 5200 |

7590 06/16/2004
Joseph T. Van Leeuwen
P.O. Box 81641
Austin, TX 78708-1641

EXAMINER

EBRAHIMI DEHKORDY, SAEID

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2626

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/726,265

Applicant(s)

DUTTA, RABINDRANATH

Examiner

Saeid Ebrahimi-dehKordy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Zehr et al (U.S. 20010025274)

Regarding claim 1 and 15 Zehr et al disclose: A method of printing documents said method comprising: receiving one or more images from one or more image providers (please note Fig.1 item 20 the advertiser, page 2 paragraph 0026 lines 1-3) receiving a print request from a user (please note Fig.12 item 200, page 7 paragraph 0072 lines 5-8) the print request including an electronic document (please note Fig.2 item 26 where the email is sent form the message transfer handler to be printed, page 2 paragraph 0027 lines 1-7) combining at least one of the images with the electronic document forming an electronic image document (please note Fig.4, page 3 paragraph 0039 lines 1-11 and page 4 lines 1-9) and printing the electronic imaged document (please note Fig.4, page 3 paragraph 0039 lines 1-20).

Regarding claim 2,9 and 16 Zehr et al disclose: The method a described in claim 1 further comprising: receiving one or more user attributes from the user; wherein the

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combining includes selecting the images based on the user attributes (please note page 7 paragraph 0067 lines 1-13).

Regarding claim 3,10 and 17 Zehr et al disclose: The method as described in claim 1 further comprising: receiving one or more target audience criteria for each image from the image provider; storing the target audience criteria matching the target audience criteria with one or more user attributes provided by the user selecting one or more images based on the matching (please note page 2 paragraph 0028 lines 1-12 and page 4 paragraph 0040 lines 13-21).

Regarding claim 4,11 and 18 Zehr et al disclose:The method as described in claim 1 further comprising: registering the image providers, the registering including: receiving payment information from each image provider (please note page 6 paragraph 0056 lines 10-18). and providing an authentication mechanism to each image provider (please note page 4 paragraph 0040 lines 1-6).

Regarding claim 5,12 and 19 Zehr et al disclose: The method as described in claim. 1 further comprising: determining a document type of the electronic document; matching the document type with one or more image document types provided by the image providers and selecting one or more images based on the matching (please note page 2 paragraph 0028 lines 1-10).

Regarding claim 6 and 13 Zehr et al disclose: The method as described in claim 1 wherein the image providers include an advertiser (please note Fig.2 item 20) the method further comprising: registering the advertiser (please note, Fig.11, Advertiser table 172 as advertiser and it's ID are registered in the table, page 7 paragraph 0070

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lines 1-14). the registering including: collecting payment information from the advertiser; and providing the advertiser with an authentication mechanism; collecting image information from the advertiser related to the image, the image information including at least one of document type and user type (please note page 6 paragraph 0056 lines 10-18). and providing an authentication mechanism to each image provider (please note page 4 paragraph 0040 lines 1-6).

Regarding claim 7,14 and 20 Zehr et al disclose: The method as described in claim 1 further comprising: registering the user the registering including: collecting one or more user attributes from the user; and providing the user with a user authentication mechanism; and determining one or more images based on the user attributes wherein the images include at least one advertisement (please note pages 3 and 4, paragraphs 0039 and 0040 lines 1-50).

Regarding claim 8 Zehr et al disclose: An information handling system comprising: one or more processors (please note page 7 paragraph 0040 lines 1-2 and also page 5 paragraph 0048 lines 6-8) a memory accessible by the processors (please note page 9 lines 1-2) a printer accessible by the processors (please note page 5 paragraph 0048 lines 6-11) a nonvolatile storage device accessible by the processors (please note page 9 lines 1-2) and a printing tool (please note Fig.8 items 100,102,104) the printing tool including: means for receiving one or more images from one or more image providers (please note pages 3 and 4 paragraphs 0039 and 0040 lines 1-40) means for receiving a print request from a user the print request including an electronic document (please note Fig.12 item 200, page 7 paragraph 0072 lines 5-8 and Fig.2 item

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26 where the email is sent from the message transfer handler to be printed, page 2 paragraph 0027 lines 1-7)

means for combining at least one of the images with the electronic document forming an electronic image document (please note Fig.4, page 3 paragraph 0039 lines 1-11 and page 4 lines 1-9) and means for printing the electronic imaged document (please note Fig.4, page 3 paragraph 0039 lines 1-20).

Contact Information

- Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Saeid Ebrahimi-Dehkordy* whose telephone number is (703) 306-3487.

The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 5:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams, can be reached at (703) 305-4863.

Any response to this action should be mailed to:

Assistant Commissioner for Patents
Washington, D.C. 20231

Or faxed to:

(703) 872-9306, or (703) 308-9052 (for **formal** communications; please mark
"EXPEDITED PROCEDURE")

Or:

(703) 306-5406 (for **informal** or **draft** communications, please label
"PROPOSED" or "DRAFT")

Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

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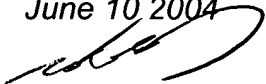
Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 305-4750.

Saeid Ebrahimi-Dehkordy

Patent Examiner

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June 10 2004



KA Williams
KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER